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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,640	11/26/2001	Robert Kuhlmann	209833US0	4060
22850	7590	12/23/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			JOHNSON, EDWARD M	
			ART UNIT	PAPER NUMBER
			1754	

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 09/991,640  
Filing Date: November 26, 2001  
Appellant(s): KUHLMANN ET AL.

MAIL ✓  
DEC 23 2004  
GROUP JO

Harris Pitlick  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/10/04.

(1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-14 and 17.

Claims 15-16 are allowed.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

Appellant's brief includes a statement that claims 1-17 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

4,495,167                    Nauroth et al.                    1-1985

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

(A)

Claims 1-14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nauroth '167.

Regarding claim 1, Nauroth '167 discloses precipitated silica having a surface area of 400-600 m<sup>2</sup>/g, pH of 6-7, DBP number of 340-380%, density of 180-220 g/l, and ALPINE sieve residue >63 microns of 25-60 (see abstract).

Nauroth '167 fails to disclose a DBP of greater than 380 g/l.

It is considered that a DBP of greater than 380 g/l would have been obvious to one of ordinary skill in the art at the time the invention was made because Nauroth discloses DBP values

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of up to 380, which would obviously, to one of ordinary skill, include at least some infinitesimal values above 380 with a reasonable expectation of achieving a similarly favorable result as that within the disclosed range. Therefore, the specific claimed silica has compositions in such close proportions to those of the prior art that, *prima facie*, one of ordinary skill in the art would have expected them to have the same properties.

See Titanium Metals Corporation of America v. Banner, 227 USPQ 773 (CAFC).

Regarding claims 2-4, Nauroth '167 discloses precipitated silica having a surface area of 400-600 m<sup>2</sup>/g, pH of 6-7, DBP number of 340-380%, density of 180-220 or 75-120 g/l, and ALPINE sieve residue >63 microns of 25-60 or 0.1 (see abstract).

Regarding claims 5-9, Nauroth '167 discloses precipitated silica comprising a surface area of 400-600 m<sup>2</sup>/g, pH of 6-7, DBP number of 340-380%, density of 180-220 or 75-120 g/l, and ALPINE sieve residue >63 microns of 25-60 or 0.1 (see abstract).

Nauroth '167 fails to disclose a solids content of 36-42 g/l.

It is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to obtain a solids content of 36-42 g/l because Nauroth discloses 46 g/l (Example 1) and about 46 g/l (see claim 4), which would

obviously, to one of ordinary skill, suggest a range of acceptable values at least including 42 g/l.

Regarding claims 10-14 and 17, Nauroth discloses use in catalysts and carriers (abstract), thickening, insulation, anti-blocking agents, and matting agents.

**(11) Response to Argument**

Issue (A)

It is argued that as confirmed by Reference Example 1 herein... Example 1 is incorrect. This is not persuasive because there appears to be no argument or evidence suggesting that Applicant's instant representation to the Office is more reliable than the earlier representation, which resulted in the cited prior art patent, which is commonly assigned and contains expired patent claims to similar subject matter. Applicant has already represented to the Office that conditions under which the process of the prior art patent were performed produced a DBP absorption value of 380g/100g. Although Applicant asserts these results were "incorrect", there is nothing on the record indicating that some other condition could have been present that caused the alleged different result. Therefore, the disclosed DBP absorption value would obviously, to one of ordinary skill, include at least some infinitesimal values above 380 with a reasonable expectation of achieving a similarly

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favorable result as that within the disclosed range. See also Titanium Metals Corporation of America v. Banner, 227 USPQ 773 (CAFC).

It is argued that in reply, and as discussed above... as high as 380. This is not persuasive for the reasons above.

It is argued that in reply, Nauroth et al discloses no recognition of... solids content or range thereof. This is not persuasive because one of ordinary skill would not require a specific definition of the term "about", as Applicant appears to suggest, to understand that a range around the disclosed data point is being referred to. Therefore, the Examiner continues to take the position that Nauroth discloses 46 g/l (Example 1) and about 46 g/l (see claim 4), which would obviously, to one of ordinary skill, suggest a range of acceptable values at least including 42 g/l. See Titanium Metals Corporation of America v. Banner, 227 USPQ 773 (CAFC).

Issue (B)

It is argued that claim 15 is patentable... with regard to Issue (A). This is not persuasive for the reasons above with respect to claim 1 and Issue (A).

It is argued that Claim 16 is patentable since Nauroth et al discloses and suggests nothing about... precipitated silica. This is not persuasive because Applicant appears to admit that

the polypropylene and polyethylene films of the cited prior art could be considered elastomers even though they are "not necessarily".

Issue (C)

It is argued that in reply, it is clear that all the claims... up to and including 420. Upon consideration, the Examiner agrees with Applicant's argument that the claimed range would be clear to one skilled in the art. However, it is noted that all claims stand rejected over Nauroth et al.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
STANLEY S. SILVERMAN  
SUPERVISORY PATENT EXAMINER  
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EMJ  
December 9, 2004

Conferees   
Thomas Dunn, Stanley 

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